

REMARKS

Claims 15-29 are pending in the present application. None of the claims were amended in this response. Favorable reconsideration is respectfully requested.

Claims 15 and 21 were rejected under 35 U.S.C. §102(e) as being anticipated by *Miller et al.* (US Patent 6,535,911). Claims 16-19, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Miller et al.* (US Patent 6,535,911) in view of *Lueh* (US Pub 2002/0144240). Claims 20, 22 and 24-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Miller et al.* (US Patent 6,535,911) in view of *Lueh* (US Pub 2002/0144240), and further in view of *Atkinson et al.* (US Pub 2002/0012329). Applicants respectfully traverse these rejections.

Specifically, the cited art, alone or in combination fails to teach telecommunication module comprising a system data processor for performing at least one telecommunication activity and a control data processor for automatically executing at least one control instruction sequence as recited in claim 15, and similarly recited in claim 21.

Regarding *Miller*, the reference teaches a system for maintaining an updated version of information originated from an original distribution media (see Abstract). In Fig. 1, *Miller* discloses a system having a viewing computer 155, a communications network 145 and a server computer 105. The viewing computer 155 includes a processor 160, a network interface 149 and storage devices 170. The network interface 149 is shown as being connected to the communications network 145 over a wireless network connection 148 (col. 4, line 55-59). The storage devices 170 are disclosed as standard storage devices (col. 4, line 67 – col. 5, line 6).

It is clear from the disclosure in *Miller* that the network interface 149 and not the viewing computer 155 corresponds to a “telecommunication module” as recited in the present claims, which are recited to comprise “a system data processor for performing at least one telecommunication activity, the at least one telecommunication activity being at least one of creating, setting up, implementing, monitoring and terminating a telecommunication with the wireless mobile communication network.” In contrast to this, the network interface 149 of *Miller* does not disclose a system data processor - the only processor mentioned in *Miller* is the processor 160 of the viewing computer. Furthermore, *Miller* does not provide any teaching or

suggestion that the processor of the viewing computer 155 could remotely be used for performing the telecommunication activity recited in claims 15 and 21.

Furthermore, claims 15 and 21 recite a telecommunication module that also comprises “a control data processor for automatically executing at least one control instruction sequence stored in the telecommunication module, the at least one control instruction sequence being implemented such that, upon execution, the at least one telecommunication activity is initiated.” Similar to the arguments submitted above, *Miller* is completely silent regarding this feature, as there is no teaching or suggestion that indicates that the network interface 149 corresponds to the telecommunication module. Furthermore, Applicants point out that the storage devices 170 is part of the viewing computer 155, and not of the network interface 149 (i.e., the telecommunication module) and also does not correspond to a control data processor for automatically executing at least one control instruction sequence stored in the telecommunication module (see col. 5, lines 3-6).

Also, claim 15 recites a connector for further connecting the telecommunication module to an external electronic device. In this context, “further” indicates that the connector is not used to connect the telecommunication module to the wireless mobile communication network but instead to the external electronic device. Support for this position can be found in FIG. 1 the present application (connector 40). Even under a “broadest reasonable interpretation,” Applicants submit this feature is not taught by *Miller*.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Miller* and *Lueh* references in the manner suggested in the Office Action. As stated previously, *Lueh* does not even mention telecommunication protocols, and the JAVA system is configured to address overhead issues pertaining to the loading of native code into a virtual memory ([0005]). There is nothing that would teach or suggest incorporating the JAVA object method of *Lueh* with the disclosure in *Miller*.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). “If the examination at the initial stage does not produce

a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).


Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In light of the above, Applicants respectfully submit that claims 15-29 are both novel and non-obvious over the art of record. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no.

02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-1019) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY  _____

Peter Zura

Reg. No. 48,196

Customer No.: 29177

Phone: (312) 807-4208

Dated: February 21, 2006